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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/604,082 06/27/00 BESSETTE

S 45112-089

EXAMINER

AFREMOVA, V

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

08/09/01

WILLEM F. GADIANO, ESQ.  
MCDERMOTT, WILL & EMERY  
600 13TH STREET, N.W.  
WASHINGTON DC 20005

HM22/0809

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/604,082	BESSETTE ET AL.	
	Examiner	Art Unit	
	Vera Afremova	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

Claims 1-11 are pending and under examination.

***Claim Rejections - 35 USC § 112***

Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed compositions (claims 1, 5 and 8) are indefinite because the differences between "carrier" and "oil compounds or derivatives" are uncertain as claimed and as intended. For example, the same component such as benzyl alcohol is claimed as an oil component/derivative (claims 2, 6 and 9) and as a carrier (claim 3). Further, the claims 2, 6 and 9 are indefinite because it is uncertain whether "oil compounds or derivatives" which are claimed are chemically pure compounds or whether they are components/derivatives of partially purified plant oils. For example: eugenol and benzyl alcohol are obtained from many natural sources including plants and plant oils and, thus, they are "plant essential oil compounds or derivatives thereof" (see Merck Index at page 3947 and page 1162).

The claim 5 is rendered indefinite by multiple combination of phrases "with or without", "with", "or", and/or". Thus, it is uncertain what components are required for the claimed composition. The metes and bounds of the claim can not be determined. It is interpreted in the instant office action that the required components are rosemary oil, piperonyl butoxide and carrier.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/30124 [IDS-3].

The claims are directed to a repellent composition for controlling insects comprising rosemary oil, carrier and additional plant essential oil compounds or derivatives. Some claims are directed to a repellent composition for controlling insects comprising rosemary oil, carrier, additional plant essential oil and conventional pesticide such as pyrethrum. Some claims are further drawn to the use of carrier such as isoparaffinic hydrocarbons, to the use of additional plant essential oil compounds or derivatives such as eugenol or benzyl alcohol. Some claims are further drawn to a method for controlling insects by applying the repellent composition to a location where insect control is desired.

WO 98/30124 [IDS-3] discloses a repellent composition for controlling insects such as parasitic fleas (page 2, lines 2-5) comprising rosemary oil, additional plant essential oils, isoparaffinic hydrocarbon carrier such as wax and conventional pesticide such as pyrethrum. For example: see page 2, lines 20-32 and page 3, lines 1-4. Thus, the disclosed composition clearly anticipates the claimed composition. With regard to additional plant essential oil compounds or derivatives such as eugenol or benzyl alcohol, for example, it is noted that these components are obtained from many natural sources including plants or plant oils. The cited patent WO 98/30124

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[IDS-3] also teaches the method for controlling undesirable insects by applying the repellent composition to a location where insect control is desired (page 2, line 5-8). Although the present invention appears to be intended for controlling cockroaches and ants, the cited method is considered to anticipate the presently claimed method because it is one active step method which comprises identical active step of applying identical composition with identical components to some unspecified location where insect control is desired. Thus, application of identical compositions is reasonably expected to produce substantially similar, if not identical, insect repellent effects as intended by applicants.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 95/07024 [N].

The claims are directed to a repellent composition for controlling insects comprising rosemary oil, carrier, additional plant essential oil compounds or derivatives, conventional pesticide such as pyrethrum and piperonyl butoxide. Some claims are further drawn to the use of additional carrier or plant essential oil compounds or derivatives such as eugenol or benzyl alcohol. Some claims are further drawn to a method for controlling insects by applying the repellent composition to a location where insect control is desired.

WO 95/07024 [N] discloses a repellent composition for controlling insects comprising rosemary oil, carrier, additional plant essential oil compounds or derivatives, conventional pesticide such as pyrethrum and piperonyl butoxide (page 5, lines 13-22). And the cited patent also teaches a method for controlling insects by applying the repellent composition to a location

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or surface where insect control is desired (page 4, lines 12-15). Thus, the claimed invention appears to be anticipated by the cited reference.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/30124 [IDS-3] taken with WO 95/07024 [N], US 4,759,930 [IDS-1] and Merck Index..

The claims are directed to a repellent composition for controlling insects comprising rosemary oil, carrier and additional plant essential oil. Some claims are directed to a repellent composition for controlling insects comprising rosemary oil, carrier, additional plant essential oil and conventional pesticide such as pyrethrum and piperonyl butoxide. Some claims are further drawn to the use of additional plant essential oil such as peppermint oil. Some claims are further drawn to the use of carrier such as isoparaffinic hydrocarbons. Some claims are further drawn to a method for controlling cockroaches by applying the repellent composition to a location containing cockroaches.

WO 98/30124 [IDS-3] and WO 95/07024 [N] are relied upon as explained above for the disclosure of insect repellent compositions with rosemary oil, carrier, additional plant essential oils, pyrethrum and piperonyl butoxide and method for controlling undesirable insects. But the cited methods are silent about controlling particular insects such as cockroaches.

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However, US 4,759,930 [IDS-1] teaches compositions with compounds derived from rosemary, pyrethrum, peppermint and other plants in a method for killing cockroaches.

In addition, Merck teaches that piperonyl butoxide is a known insecticide synergist (pages 7625-7627).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use the repellent compositions with rosemary oil and other plant oils and/or plant derivatives as taught by the references WO 98/30124 [IDS-3] and WO 95/07024 [N] in a method for controlling insects such as cockroaches with a reasonable expectation in success in killing cockroaches because it is known that the claimed plant or plant derivatives are effective in cockroach extermination as taught by US 4,759,930 [IDS-1]. Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary. And the incorporation of conventional solvents or carriers is considered to be within the purview of the ordinary skill practitioner in the field of insect control or extermination. The claimed subject matter fails to patentably distinguish over the state art as represented by the cited references. Therefore, the claims are properly rejected under 35 USC § 103.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vera Afremova whose telephone number is (703) 308-9351. The examiner can normally be reached on 9.30 am - 6.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on (703) 308-4743. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Vera Afremova  
AU 1651  
August 2, 2001.

SANDRA E. SAUCIER  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'S. Saucier', written over the printed name and title.